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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,564	11/28/2001	Carol T. Schembri	10981612-2	5249

7590 09/10/2003  
AGILENT TECHNOLOGIES, INC.  
Legal Department, DL429  
Intellectual Property Administration  
P.O. Box 7599  
Loveland, CO 80537-0599

EXAMINER

TRAN, MY CHAU T

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 09/10/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application N .

09/997,564

Applicant(s)

SCHEMBRI, CAROL T.

Examiner

My-Chau T. Tran

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 17-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-7 and 17-27 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1639

### **DETAILED ACTION**

1. Applicant's amendment filed 11/28/01 in Paper No. 3 is acknowledged and entered.

Claims 8-16 are canceled by the amendment.

2. Claims 1-7, and 17-27 are pending.

### ***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to a method for modifying a portion of a substrate surface, classified in class 436, subclass 518.
- II. Claim 17, drawn to a substrate, classified in class 435, subclass 283.1.
- III. Claims 18-19, drawn to a polymeric array, classified in class 435, subclass 287.1.
- IV. Claim 20, drawn to a nucleic acid array, classified in class 435, subclass 287.2.
- V. Claims 21-23, drawn to a kit, classified in class 422, subclass 61.
- VI. Claims 24-27, drawn to a method of detecting the presence of an analyte in a sample, classified in class 435, subclass 7.1.

The inventions are distinct, each from the other because of the following reasons:

4. Inventions of Group I and Group VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the

Art Unit: 1639

instant case the different inventions (methods) require different reagents that have different functions and different effects and would produced different products/results.

The method step of producing a solvent layer on a substrate surface of Group I is not required by the claims of Group VI. The method step of detecting the presence of binding complexes of Group VI is not required by the claims of Group I.

5. Inventions of Groups II, III, IV, and V are unrelated. Inventionis are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions (product/apparatus) have different required components that have different modes of operation and different functions.

The feature of only a substrate of Group II is not required by the claims of Group III, IV, and V. The combination of a plurality of distinct polymers and a plurality of resistors of Group III are not required by the claims of Groups II, IV, and V. The combination of a plurality of nucleic acid and a plurality of resistors of Group IV are not required by the claims of Groups II, III, and V. The combination of a deblocking agent and a plurality of resistors of Group V are not required by the claims of Groups II, III, and IV.

6. Inventions of Group I (process) and Group II (product) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP §

Art Unit: 1639

806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as the process of chemical deposition or ink-jet printing. This restriction requirement is also applicable with the apparatus of Group III (polymeric array), Group IV (nucleic acid array), and Group V (kit).

7. Inventions of Group VI (process) and Group II (apparatus) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus (substrate) as claimed can be used to practice another and materially different process such as the process of protein synthesis. This restriction requirement is also applicable with the apparatus of Group III (polymeric array), Group IV (nucleic acid array), and Group V (kit).

8. Because these inventions are distinct for the reasons given above and the searches required are not co-extensive thus requiring a burdensome search, restriction for examination purposes as indicated is proper. Additionally, different patentability considerations are involved for each group. For example, a patentability determination for Group III would involve a determination of the patentability of the nucleic acid array while a patentability determination for Group VI would involve a consideration of the patentability of the method of detecting the presence of an analyte in a sample. These considerations are very different in nature.

Art Unit: 1639

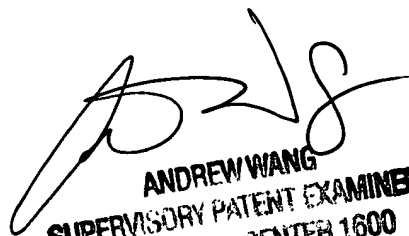
9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999. The examiner is on Increased Flex Schedule and can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 703-306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

mct  
September 6, 2003



ANDREW WANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600